

ESTTA Tracking number: **ESTTA662311**

Filing date: **03/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	RSM International Association
Granted to Date of previous extension	04/19/2015
Address	11 Old Jewry, 2nd Floor London, EC2R 8DU UNITED KINGDOM
Attorney information	Michael H. Selter Manelli Selter PLLC 2000 M Street, N.W., 7th Floor Washington, DC 20036 UNITED STATES mselter@mdslaw.com Phone:202-261-1026

Applicant Information

Application No	86273073	Publication date	10/21/2014
Opposition Filing Date	03/20/2015	Opposition Period Ends	04/19/2015
Applicant	RSM Consulting 724 Alta Avenue Santa Monica, CA 90402 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. First Use: 2014/04/14 First Use In Commerce: 2014/04/14 All goods and services in the class are opposed, namely: Assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization; Business management consulting, strategic planning and business advisory services provided to for profit and non profit organizations; Business organisation consulting; Business strategic planning services; Business support services, namely, business consulting to freelancers, start-ups, existing businesses and non-profit organizations; Consultancy and advisory services in the field of business strategy; Marketing consulting services relating to long-term business strategy development for non-profit organizations; New business venture development and formation consulting services; Personnel consultancy; Personnel management consultation; Professional business consultation
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4449481	Application Date	08/30/2012
Registration Date	12/17/2013	Foreign Priority Date	03/28/2012
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a sphere containing two intersecting curved bands.		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Accountancy services and advisory and consultancy services in the field of accountancy</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Financial consultation; financial analysis and research services; financial advice; financial consulting and advising in the field of mergers and acquisitions; financial and investment services, namely, asset and investment acquisition services, consultation services, advisory services and development services; financial valuations; financial services, namely, corporate workouts, debt restructurings, receiverships, and loan resolutions for commercial loans; strategic corporate financial advisory services, financial management; financial risk management consultation; financial due diligence; financial consultation concerning working capital</p>		

U.S. Registration No.	4278429	Application Date	01/28/2012
Registration Date	01/22/2013	Foreign Priority Date	NONE
Word Mark	RSM		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Accounting services and advisory and consulting services in the field of accounting</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Financial management services, financial planning services, financial portfolio-management services, financial forecasting services, financial guarantee and surety services, financial research, analysis and consultation services, financial-information provided by electronic means and advisory and consulting services in the field of financial services</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Educational services namely providing training, seminars, educational conferences and international meetings, all in the field of accounting, financial management, financial planning, financial portfolio management, financial forecasting, financial guarantee and surety, financial research, analysis and consultation</p>

U.S. Registration No.	3115625	Application Date	07/22/2003
Registration Date	07/18/2006	Foreign Priority Date	01/23/2003
Word Mark	RSM! INTERNATIONAL		
Design Mark			
Description of Mark	The mark consists of the words "RSM INTERNATIONAL" with the "M" in "RSM" being a combination of the letter "M" and "!".		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 accounting services and advisory and consulting services in the field of accounting</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 financial management services, financial planning services, financial portfolio-management services, financial forecasting services, financial guarantee and surety services, financial research, analysis and consultation services, financial-information provided by electronic means and advisory and consulting services in the field of financial services</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 [educational services, namely, providing training, seminars and educational conferences and international meetings, all in the field of accounting, financial management, financial planning, financial portfolio management, financial fore-</p>		

	casting, financial guarantee and surety, financial research, analysis and consultation]
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Attachments	79122609#TMSN.png(bytes) 85527866#TMSN.png(bytes) 76531112#TMSN.png(bytes) Notice of Opposition - RSM Global(2).pdf(55371 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Signature	/s/ Michael H. Selter
Name	Michael H. Selter
Date	03/20/2015

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RSM INTERNATIONAL)		
ASSOCIATION,)		
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)		
Opposer,)	Opposition No.:	_____
)		
v.)	Application No.:	86/273,073
)		
RSM CONSULTING DBA)	Publication Date:	October 21, 2014
RSM GLOBAL LLC)		
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Applicant.)		
)		

Opposer, RSM International Association (“Opposer”), a United Kingdom limited corporation with its principal place of business at 2nd Floor, 11 Old Jewry, London EC2R 8DU, UNITED KINGDOM, hereby opposes registration of a design mark with the literal element RSM GLOBAL, which is the subject of application Serial No. 86/273,073, published in the *Official Gazette* of October 21, 2014, and which was filed by Applicant RSM Consulting d/b/a RSM Global LLC (“Applicant”), a California corporation with its principal place of business at 724 Alta Avenue, Santa Monica, California 90402.

Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

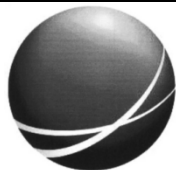
The reasons for which Opposer believes it will be damaged by the registration, and the grounds for opposition, are as follows:

1. Opposer is an international network of independent accounting and advisory firms. In addition to traditional service lines of audit and assurance, accounting and tax, RSM member firms provide a diverse range of business solutions and consulting services. These include corporate finance and transaction support, cross-border tax and expatriate services, corporate governance and risk assurance services and business restructuring, outsourcing and general management consultancy.

2. McGladrey LLP is the United States firm that is part of Opposer's network.

3. Opposer and McGladrey LLP, prior to any date of first use upon which Applicant can rely, have used the marks shown below in commerce and without abandonment to promote the services provided by McGladrey LLP in the United States.

4. Opposer is the owner of the following registered marks.

Reg. No.	Mark	Classes and Goods and Services
4,449,481		35/ Accountancy services and advisory and consulting services in the field of accountancy 36/ Financial consultation; financial analysis and research services; financial advice; financial consulting and advising in the field of mergers and acquisitions; financial and investment services, namely, asset and investment acquisition services, consultation services, advisory services and development services; financial valuations; financial services, namely, corporate workouts, debt restructurings, receiverships, and loan resolutions for commercial loans; strategic corporate financial advisory services, financial management; financial risk management consultation; financial due diligence; financial consultation concerning working capital
4,278,429	RSM	35/ Accounting services and advisory and consulting services in the field of accounting 36/ Financial management services, financial planning services, financial portfolio management services, financial forecasting services, financial guarantee and surety services, financial research, analysis and consultation services, financial information provided by electronic means and advisory and consulting services in the field of financial services 41/ Educational services namely providing training, seminars, educational conferences and international meetings, all in the field of accounting, financial management, financial planning, financial portfolio management, financial forecasting, financial guarantee and surety, financial research, analysis and consultation

3,115,625	RSM International	35/ Accounting services and advisory and consulting services in the field of accounting 36/ Financial management services, financial planning services, financial portfolio management services, financial forecasting services, financial guarantee and surety services, financial research, analysis and consultation services, financial information provided by electronic means and advisory and consulting services in the field of financial services
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5. Applicant has filed an application to register its design mark with the literal element RSM GLOBAL. The basis for the application is Section 1(a) of the Trademark Act. The application was filed on May 6, 2014, with a claimed date of first use of April 14, 2014 , and was assigned Serial No. 86/273,073. This date of first use is after the priority dates of Opposer's marks

6. Applicant is seeking to register the mark in the following class and for the following services:

IC 035. Assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization; Business management consulting, strategic planning and business advisory services provided to for profit and non profit organizations; Business organisation consulting; Business strategic planning services; Business support services, namely, business consulting to freelancers, start-ups, existing businesses and non-profit organizations; Consultancy and advisory services in the field of business strategy; Marketing consulting services relating to long-term business strategy development for non-profit organizations; New business venture development and formation consulting services; Personnel consultancy; Personnel management consultation; Professional business consultation

7. RSM GLOBAL is the literal and therefore dominant element of Applicant's mark. RSM GLOBAL is confusingly similar to the RSM mark in Reg. No. 4,278,429, particularly since the word "Global" was disclaimed and therefore does not distinguish the mark.

8. The design, as the secondary element, also does not distinguish Applicant's mark. Moreover, the design is similar to the globe in Reg. No. 4,449,481. A consumer who is aware of Opposer's marks is likely to be confused as to the source or sponsorship of Applicant's services.

9. Applicant's services promoted by its mark are substantially the same as the services promoted by Opposer's marks.

10. For all these reasons, Applicant's design mark with the literal element RSM GLOBAL so resembles Applicant's registered marks as to be likely, when applied to the services set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

WHEREFORE, Opposer prays that the opposition be sustained and that registration to Applicant be refused.

Opposer hereby appoints Michael H. Selter and Stuart E. Benson and, members of the bar of the District of Columbia, of Manelli & Selter PLLC, 2000 M Street, Suite 700, Washington, DC 20036, to act as attorneys in the matter of this opposition, and to receive all communications relating to the same.

Dated: March 20, 2014

Respectfully submitted,

By: /Michael Selter/
Michael H. Selter
Stuart E. Benson
MANELLI SELTER PLLC
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Washington, D.C. 20036

Attorneys for Opposer
RSM International Association